

### **REMARKS**

The Office Action dated September 30, 2010 (hereinafter, “Office Action”) has been reviewed and the Examiner’s comments considered. Claims 1-8 and 10-30 are pending in the application. Claims 2, 6, 7, 13, 15, 17-20, 25, and 28 are withdrawn. Claims 12, 16, and 29 have been canceled by this amendment. Claims 1 and 11 are amended herein, support for which can be found in the originally filed application at, for example, pages 6-8 and FIGS. 1-2. Applicants submit that no new matter is introduced, and respectfully request entry of the amendments.

#### **Claim Rejections – 35 U.S.C. § 103**

Claims 1, 3-5, 8, 10-12, 14, 16, 21-23, 26, 27, 29, and 30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over USPN 6,450,976 to Korotko et al. (hereinafter, “Korotko”) in view of USPN 6,299,602 to Miller et al. (hereinafter, “Miller”). Claim 24 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Korotko in view of USPN 4,976,721 to Blasnik et al. (hereinafter, “Blasnik”). Applicants respectfully traverse these rejections.

The Office Action alleges that Korotko teaches “a bore adjacent the gripping jaw.” (Office Action, pp. 2 and 5.) The Office Action admits, however, that Korotko “fails to disclose the gripping jaw comprising an attachment side and a pair of lever member[s] positioned to selectively open the gripping jaw.” (Office Action, pp. 2 and 5-6.) The Office Action relies on Miller to provide such a teaching. The clip 220 of Miller, however, does not show or describe “an attachment member including a gripping jaw comprising an attachment side and a pair of lever members positioned to selectively open the gripping jaw, and a bore adjacent the gripping jaw, wherein the elongate body is positioned through the bore,” as recited in independent claims 1 and 11.

A *prima facie* case of obviousness is not established if the “suggested combination of references would require a substantial reconstruction and redesign of the elements shown in the primary reference as well as a change in the basic principle under which the primary reference construction was designed to operate.” MPEP § 2143.01(VI) quoting *In re Ratti*, 270 F.2d 810, 813, 123 USPQ 349, 352 (CCPA 1959). Combining the primary and secondary references as

proposed by the Examiner would require a substantial reconstruction and design of the primary reference, thereby making the combination improper.

The claimed invention cannot be arrived at by simply substituting the clip 220 of Miller for the alleged hub clamp 11 of Korotko. Rather, a substantial reconstruction of the alleged attachment member is required. This would require hub clamp 11 to be substantially reconstructed to be more like the clip 220 of Miller, while retaining the alleged bore. Additionally, Miller provides almost no details regarding the clip. Neither Korotko nor Miller show or describe how such a clip with a bore adjacent the gripping jaw might be configured.

Moreover, the Office Action relies on the teaching of a hub clamp 11 from Korotko allegedly including a bore to support a combination of the alleged bore with a clip from Miller. However, Miller does not include “a bore adjacent the gripping jaw,” as recited in claims 1 and 11. The Office Action alleges that “[i]t would have been obvious . . . to modify the attachment member of Korotko to have a pair of lever members to selectively open the gripping jaw.” (Office Action, p. 3.) However, the clip 220 of Miller has a post like structure extending perpendicular to the rest of the clip instead of a bore. Thus, even assuming *arguendo* that Korotko and Miller can properly be combined, a person of ordinary skill in the art at the time of the invention would use the post-like structure that is already present to attach the clip 220 to apparatus 10 of Korotko rather than removing the structure and fashioning a bore in its place.

Notwithstanding the foregoing arguments, in the interest of compact prosecution, independent claims 1 and 11 have been amended to further distinguish the asserted combination of Korotko/Miller.

Neither Korotko nor Miller, alone or in combination show or describe the claimed features. The outer barrel 14, alleged to be the “elongate body” is a single cylindrical structure. As recited in independent claim 1, the sleeve abutment surface and a shaft abutment surface are both coupled to the shaft. Further, claim 1 recites the elongate body first end including a slot that the sleeve abutment surface is slidably disposed in. The Office Action alleges with respect to the rejection of

claim 12, that Korotko discloses “a slot (38),” however, the alleged “sleeve abutment surface” is not slidably disposed in the alleged slot 38. Rather, the clamp 22 that travels through passageway 38, not the alleged sleeve abutment surface. (Korotko, col. 5, ll. 23-24.)

Similar to the sleeve abutment surface and a shaft abutment surface recited in claim 1, claim 11 includes first and second spacing members. The Office Action alleges with respect to the rejection of claims 16 and 29 that Korotko “discloses a second spacing member (11) coupled to the second end of the elongate body (Fig. 1, 5).” (Office Action, p. 8; a similar rejection of claim 29 is discussed in the Office Action, p. 9.) The Office Action also alleges that Korotko reference character (11) is the attachment member. The recited elements of the attachment member and the second spacing member are each separate and independent features of the recited devices of claims 1 and 11. They cannot be shown or suggested by a single element from the cited art as has been alleged in the Office Action.

Accordingly, independent claims 1 and 11 are patentable over Korotko. Dependent claims 3-5, 8, 10, 12, 14, 16, 21-23, 26, 27, 29, and 30 are patentable because they depend from a patentable independent claim, and also because they recite features not shown or described by the cited art. Therefore, Applicants request favorable reconsideration and withdrawal of the rejections under 35 U.S.C. § 103.

With respect to the rejection of claim 24 under 35 U.S.C. § 103 as being unpatentable over Korotko in view of Blasnik, without conceding the assertions made in the Office Action with respect to the allegedly disclosed subject matter, Applicants submit that the rejected claim depends from a patentable independent claim, in view of the above, and is therefore patentable. Accordingly, Applicants request favorable reconsideration and withdrawal of the rejections under 35 U.S.C. § 103.

### Conclusion

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejections of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

It is noted that the remarks herein do not constitute, nor are they intended to be, an exhaustive enumeration of the distinctions between the cited references and the claimed invention. Rather, the distinctions identified and discussed herein are presented solely by way of example. Consistent with the foregoing, the discussion herein should not be construed to prejudice or foreclose future consideration by Applicants of additional or alternative distinctions between the claims of the present application and the references cited by the Examiner and/or the merits of additional or alternative arguments.

Applicants believe no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 50-2191, under Order No. 101671.0010P from which the undersigned is authorized to draw.

Dated: December 30, 2010

Respectfully submitted,

Electronic signature: /Todd W. Wight/  
Todd W. Wight

Registration No.: 45,218  
RUTAN & TUCKER LLP  
611 Anton Boulevard, Suite 1400  
Costa Mesa, California 92626  
(714) 641-5100  
Patents@Rutan.com